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10/671,310	09/25/2003	Takayuki Yajima	848075/0057	8023

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SCHULTE ROTH & ZABEL LLP  
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NEW YORK, NY 10022

EXAMINER
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ZEWDU, MELESS NMN

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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12/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/671,310

**Applicant(s)**

YAJIMA, TAKAYUKI

**Examiner**

Meless N. Zewdu

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment (RCE)*

1. This action is in response to the communication filed on 10/22/07.
2. Claims 1-18 are pending in this action.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5, 7, 8, 11, 12 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Toba (US 6,907,276 B2). For examination purposes, claim 11 is considered firs.

**As per claim 11:** Toba discloses a method of displaying an input screen of a display unit of a portable terminal having housings open-ably and close-ably connected Together (see figs. 1 and 2; col. 6, lines 48-58), comprising the steps of:

selecting an item to be displayed on said display unit while said

portable terminal is in a closed state (see col. 6, line 59-col. 7, line 2; col. 7, line 58-col. 8, line 6; col. 12, lines 23-56; col. 19, lines 5-53; ). Scrolling (see col. 12, lines 49-56) is a means of selecting an item to be displayed.

changing a non-input (external) screen of said display unit having an item selected thereon to an input screen corresponding to said selected item when either of said housings is opened from said closed state (see 8, lines 37-49; col. 10, line 59-col. 11, line 20; col. 14, lines 7-51).

**As per claim 12:** Toba discloses a method, wherein said non-input (external) screen has a guide view informing a user to open either of said housings from said closed state (see fig. 2, element 11; col. 7, line 67-col. 8, line 6).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toba (US 6,907,276 B2) in view of Nishiyama et al. (Nishiyama) (US 5,710,576).

**As per claim 1:** Toba discloses a portable terminal having an open state and a closed state (see figs. 1 and 2; col. 6, lines 48-58), said portable terminal comprising:

a first housing having a main display unit with a screen (see fig. 1, elements 3 and 5; col. 6, line 59-col. 7, line 2);

a second housing having at least an input unit (see fig. 1, elements 4 and 8; col. 6, line 59-col. 7, line 2);

a detecting means for detecting opening of either of said housings (see fig. 1, element 6; col. 6, line 59-col. 7, line 2; col. 4, lines 39-65); and

a control means for controlling said screen of said main display unit (see col. 3, lines 38-53; col. 7, line 58-col. 8, line 6; col. 8, lines 28-49);

wherein said first housing is open-ably and close-ably connected to said second housing (see figs. 1 and 2; col. 6, lines 48-58); and wherein, when said detecting means detects opening of either of said housings, said control unit changes a non-input screen of an item to be displayed on said main display unit in the closed state to an input screen corresponding to said item (see col. 6, line 47-col. 7, line 2; col. 7, line 58-col. 8, line 6; col. 8, lines 27-49). But, Toba does not explicitly teach about a main display unit that is visible to a user in at least a closed state of a portable terminal, as recited and further argued by applicant. However, in the same field of endeavor, Nishiyama teaches about a portable electronic apparatus having partially display function, wherein the apparatus, having a first and second housings which are closeable and openable and wherein the main display is partially visible to a user when the housings are in a closed state (see col. 1, line 54-col. 2, line 39, particularly col. 2, lines 2-11). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Toba with that of Nishiyama

for the advantage of viewing information in the closed state of a portable terminal (see col. 1, lines 58-61).

**As per claim 2:** Toba discloses a portable terminal, further comprising:

a selecting unit (fig. 3, element 21) for selecting an item displayed on said main display unit (see col. 12, lines 45-56) (wherein scrolling indicates selection); wherein when said detecting means detects opening of either of said housings, said control device changes said screen with an item selected by said selecting unit to an input screen corresponding to said item (see col. Col. 3, lines 38-53; col. 8, line 27-49).

**As per claim 4:** Toba discloses a portable terminal, wherein said portable terminal is a portable telephone (see fig. 1; abstract; col. 6, line 47-col. 7, line 2).

**As per claim 5:** Toba discloses a portable terminal having a closed state and an open state (see figs. 1 and 2; col. 6, lines 48-58), said portable terminal comprising:

a first housing having a main display unit with a screen (see fig. 1, elements 3 and 5; col. 6, line 59-col. 7, line 2);

a second housing having at least an input unit (see fig. 1, elements 4 and 8; col. 6, line 59-col. 7, line 2);

a detecting means for detecting opening of either of said housings (see fig. 1, element 6; col. 6, line 59-col. 7, line 2; col. 4, lines 39-65); and

a control means for controlling said screen of said main display unit (see col. 3, lines 38-53; col. 7, line 58-col. 8, line 6; col. 8, lines 28-49);

wherein said first and said second housings are open-ably and close-ably connected together (see figs. 1 and 2; col. 6, lines 48-58); wherein said input unit is visible to a user in said open state, and wherein, when said detecting means detects opening of either of said housings, said control unit changes a non-input screen of an item to be displayed on said main display unit in closed state to an input screen corresponding to said item (main display) (see col. 6, line 47-col. 7, line 2; col. 7, line 58-col. 8, line 6; col. 8, lines 27-49). But, Toba does not explicitly teach about a main display unit that is visible to a user in at least a closed state of a portable terminal, as recited and further argued by applicant. However, in the same field of endeavor, Nishiyama teaches about a portable electronic apparatus having partially display function, wherein the apparatus, having a first and second housings which are closeable and openable and wherein the main display is partially visible to a user when the housings are in a closed state (see col. 1, line 54-col. 2, line 39, particularly col. 2, lines 2-11). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Toba with that of Nishiyama for the advantage of viewing information in the closed state of a portable terminal (see col. 1, lines 58-61).

**As per claim 7:** Toba discloses a portable terminal, wherein said portable terminal is a portable telephone (see fig. 1; abstract; col. 6, line 47-col. 7, line 2).

**As per claim 8:** Toba discloses a portable terminal having a closed state and an open state (see figs. 1 and 2; col. 6, lines 48-58), said portable terminal comprising:

a first housing having at least a display unit, said display unit being

switchable between an input mode and a non-input mode (see fig. 1, element 5 and fig. 2, element 11; col. 6, lines 47-58; col. 8, lines 28-49);

a second housing having at least an input unit (see fig. 1, elements 4 and 8; col. 6, line 59-col. 7, line 2);

a detecting means for detecting opening of either of said housings (see fig. 1, element 6; col. 6, line 59-col. 7, line 2; col. 4, lines 39-65); and

a control means for switching said display unit between said non-input mode and said input mode (see col. 3, lines 38-53; col. 7, line 58-col. 8, line 6; col. 8, lines 28-49). Note: the non-input and input modes displays correspond to the main and supplemental displays of the prior art.

wherein said housings are openably and closably connected together (see figs. 1 and 2); and wherein when said detecting means detects opening of either of said housings (col. 7, lines 16-30), said control means switches said display unit from said non-input mode to said input mode (main display mode) (see col. 6, line 47-col. 7, line 2; col. 7, line 58-col. 8, line 6; col. 8, lines 27-49). But, Toba does not explicitly teach about a main display unit that is visible to a user in at least a closed state of a portable terminal, as recited and further argued by applicant. However, in the same field of endeavor, Nishiyama teaches about a portable electronic apparatus having partially display function, wherein the apparatus, having a first and second housings which are closeable and openable and wherein the main display is partially visible to a user when the housings are in a closed state (see col. 1, line 54-col. 2, line 39, particularly col. 2, lines 2-11). Therefore, it would have been obvious for one of ordinary skill in the art at the



time the invention was made to modify the teaching of Toba with that of Nishiyama for the advantage of viewing information in the closed state of a portable terminal (see col. 1, lines 58-61).

**As per claim 15:** the features of claim 15 are similar to the features of claim 1. Hence, claim 15 is rejected on the same ground and motivation as claim 1.

**As per claim 16:** the features of claim 16 are similar to the features of claim 1. Hence, claim 16 is rejected on the same ground and motivation as claim 1.

**As per claim 17:** the features of claim 17 are similar to the features of claim 1. Hence, claim 17 is rejected on the same ground and motivation as claim 1.

Claims 9, 10, 13, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toba in view of Matsumoto et al. (Matsumoto) (US 2002/0119768 A1). For examination purpose, claim 13 is considered first.

**As per claim 13:** Toba discloses a method of displaying an input screen of a display unit of a portable terminal having housings open-ably and close-ably connected together (see figs. 1 and 2; col. 6, lines 48-58), comprising the steps of:

receiving an electronic mail message (see abstract; col. 3, lines 22-36);

displaying said received electronic mail message on a non-input (external) screen of said display unit (see fig. 2, element 11; col. 3, lines 22-36; col. 7, line 58-col. 8, line 6); and

changing said non-input screen displaying said received electronic mail message to an input screen ( see col. 8, lines 27-49). Further more, Toba discloses displaying received electronic mail message when either of said housings is opened

from its closed state (see col. 3, lines 38-53). But, Toba does not explicitly teach/disclose about editing the received email/electronic mail message, as claimed by applicant. However, in a related field of endeavor, Matsumoto teaches about portable terminal (mobile station/telephone (see fig. 1) wherein a user of the mobile station may use a text editing function, such as electronic mail (email) which is provided for the mobile station (see page 1, paragraphs 008-009). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Toba with that of Matsumoto for the advantage of conveying information/message to a party without omission (see page 1, paragraph 008).

**As per claim 14:** Toba discloses a method, wherein said non-input (external) screen has a guide view informing a user to open either of said housings from said closed state (see fig. 2, element 11; col. 7, line 67-col. 8, line 6).

Claims 9, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toba and in views of Nishiyama and Matsumoto.

**As per claim 9:** Toba discloses a portable terminal having a closed state and an open state (see figs. 1 and 2; col. 6, lines 48-58) said portable terminal comprising:

a first housing having a main display unit, said main display unit including a screen changeable between an input screen and a non-input screen (see figs. 1 and 2 and corresponding elements 5 and 11). Note: elements 5 and 11 correspond to the input and non-input display modes/screens (see also abstract; col. 7, line 58-col. 8, line 6; col. 8, lines 27-36).

a second housing having at least an input unit (see fig. 1, elements 4 and 8; col. 6, line 59-col. 7, line 2);

a detecting means for detecting opening of either of said housings see fig. 1, element 6; col. 6, line 59-col. 7, line 2; col. 4, lines 39-65); and

a reception means for receiving an electronic mail message (see abstract; col. 7, line 41-col. 8, line 6); and

a control unit for selectively displaying said received electronic mail message on said screen of said display unit (see abstract; col. 7, lines 16-30; col. 7, line 58-col. 8, line 6), and for changing said screen of said display unit (col. 8, lines 27-49); wherein said housings are openably and closably connected together (see figs. 1 and 2; col. 6, lines 48-58); and wherein when said detecting means detects opening of either of said housings (see fig. 1, element 6; col. 6, lines 48-58; col. 7, lines 16-30), said control means changes said non-input screen displaying said received e-mail to said input screen (main screen) (see col. 8, lines 21-49). But, Toba does not explicitly teach about a main display unit that is visible to a user in at least a closed state of a portable terminal, as recited and further argued by applicant. However, in the same field of endeavor, Nishiyama teaches about a portable electronic apparatus having partially display function, wherein the apparatus, having a first and second housings which are closeable and openable and wherein the main display is partially visible to a user when the housings are in a closed state (see col. 1, line 54-col. 2, line 39, particularly col. 2, lines 2-11). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Toba with that of Nishiyama

for the advantage of viewing information in the closed state of a portable terminal (see col. 1, lines 58-61). But, Toba in view of Nishiyama does not does not explicitly teach about editing a received email, as claimed by applicant. However, in the same field of endeavor, Matsumoto teaches about portable terminal (mobile station/telephone (see fig. 1) wherein a user of the mobile station may use a text editing function, such as electronic mail (email) which is provided for the mobile station (see page 1, paragraphs 008-009). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Toba in view of Nishiyama with that of Matsumoto for the advantage of conveying information/message to a party without omission (see page 1, paragraph 008).

**As per claim 10:** Toba teaches about a portable terminal, wherein said control means changes said non-input screen displaying said received e-mail to said input screen and displays said received e-mail on said input screen (see abstract; col. 7, line 58-col. 8, line 6; col. 8, lines 27-49).

Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied to claims 1 and 5 above, and further in view of Lenchik et al. (Lenchik) (US 6,658,272 B1).

**As per claim 3:** but, Toba does not explicitly teach about a portable terminal, according to claim 1, wherein said portable terminal is a personal digital assistant, as claimed by applicant. However, in a related field of endeavor, Lenchik teaches about a self configured portable electronic device, that can be configured as a personal digital assistant (figs 5- 8; col. 3, lines 13-40) and a cellular telephone ( see col. 2, line 2-col.

3, line 12). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Toba with that of Lenchik (configuring portable terminal into PDA) for the advantage of using large display the PDA provides (see col. 1, lines 10-24).

**As per claim 6:** but, Toba does not explicitly teach about a portable terminal, according to claim 1, wherein said portable terminal is a personal digital assistant, as claimed by applicant. However, in a related field of endeavor, Lenchik teaches about a self configured portable electronic device, that can be configured as a personal digital assistant (figs 5- 8; col. 3, lines 13-40) and a cellular telephone ( see col. 2, line 2-col. 3, line 12). The motivation same as provided in the rejection of claim 3.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-10 and 15-18 have been considered but are moot in view of the new ground(s) of rejection. However, the previous rejection is maintained with regard to claims 11-14. No response has been made regarding the latter claims since there was no argument presented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N. Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Appiah Charles can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application or proceedings should be directed to the receptionist whose telephone number is (571) 272 2600.

Meless zewdu



Patent examiner

129 November 2007.